Moreover, there are myriad reasons why, even if a transnational jurisdictional issue were otherwise worthy of this Court's review, this case is a poor vehicle. Chief among these is an unresolved jurisdictional issue wherein RIM itself has taken, and has not disavowed, the position that this case is moot so that *no federal court has jurisdiction over this matter.* Additionally, a decision on the narrow question presented in this case, at this time, would not control its ultimate resolution. Because the facts of this case present none of the complications RIM believes makes the question it raises worthy of this Court's review, the proper course is to address these issues only if the Federal Circuit, applying long-standing circuit precedent that has been reaffirmed by Congress, is unable to resolve such speculative complications in the future.

STATEMENT OF THE CASE

A. Legal and Factual Background

Every day, as RIM touts to this Court, thousands of RIM BlackBerry customers within the United States, ranging from individuals to business entities of all sizes and state, local, and federal governments, use BlackBerry wireless devices and software to receive, view, and process email messages. RIM did not appeal the jury's finding that "its customers use, *i.e.*, put into service, the systems and methods for transmitting email messages." *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1314 (Fed. Cir. 2005) ("*NTP III*"), Pet. 51a. Nor does RIM dispute before this Court that its systems fall within the claims of a number of NTP patents. RIM's sole contention is that use of the systems by its American customers does not take place "within the United States" so that 35 U.S.C. § 271(a) does not apply to customer use.[1] RIM has not appealed the ruling that, given customer use "within the United States," it was properly held liable for contributory infringement and inducement.

Stripped of its rhetoric and inapposite references to the "Internet" and "global systems," RIM's position is that the displacement of one internal component of the Campana

[1] Because the Federal Circuit determined that RIM's American customers use the infringing system within the United States, it did not need to reach any of the jury's alternative grounds for finding infringement. *See infra* Part III.E.

patented system[2] outside the United States renders the entire system incapable of being used "within the United States," regardless of where and by whom the relevant email messages are originated and received or where the use of the system is initiated. To state RIM's proposition clearly is the best demonstration of how it distorts the plain language of 35 U.S.C. § 271(a). Only RIM could conceive of the notion that its system could be used by customers to send and receive domestic messages in many countries around the world but not be used "within" any of them.

1. The Campana Patents

In 1990, long before the term "internet" entered the public lexicon, Thomas Campana, the lead inventor at NTP, developed and subsequently patented a system for transmitting and receiving messages received by electronic mail systems wirelessly, through radio frequency ("RF") networks. As was undisputed at trial, Campana had a fully functional nationwide system for delivery of wireless email by 1991. Campana was a pioneer in the wireless data field, with over 50 patents to his credit. The inventions at issue were based on a patented data messaging system that he had developed in the 1980s, which delivered data (such as paging and stock quotes) to recipients as the data became available, without requiring that the user request updates or take any action whatsoever. In modern parlance, this data system "pushed" information to its recipients, rather than forcing the recipients to "dial-in" and "pull" information from the information source.

In the patents at issue here, Campana's pioneering contribution was to devise a system that allows electronic mail messages to be pushed from an email system in real time to

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[2] In a transparent attempt to magnify the importance of this single piece of the integrated BlackBerry system, RIM minted a new "Network Control Center" appellation for the "Relay" on appeal, Pet. 4 n.1, but that which we call a Relay by any other name performs the same limited function in the patented system. For the purposes of this litigation, no matter what other "super-intelligent" abilities are incorporated into the Relay, *id.* at 4, the only relevant issue is that the Relay serves the function of the "interface" or "interface switch" limitation described in certain claims in certain of the Campana patents. *NTP III*, Pet. 50a.

an interface with RF networks from which the messages are delivered wirelessly to the recipients. Prior to Campana's innovation, electronic mail systems and wireless messaging systems both existed, but were not integrated. To receive electronic mail, a user had to either sit at a terminal that was physically connected to a data network or dial in to a data network using a portable computer, a modem, and a telephone line. This made accessing electronic mail outside of the office environment difficult, inconvenient, and time-consuming. The user also could go through the inconvenience of logging in to the network only to find that she had no new messages. *NTP III*, Pet. 4a-5a.

Campana's patent thus described a novel system:

> The present invention provides an integration of an electronic mail system with a RF information transmission network for transmitting electronic mail originating at processors either within or outside an electronic mail system by RF communication to at least one destination processor within an electronic mail system by an RF receiver which relays the information to the destination processor . . . .

U.S. Patent No. 5,436,960, col. 18, ll. 32-39. As the Federal Circuit explained, the Campana invention allows "[a] message originating in an electronic mail system [to] be transmitted not only by wireline but also via RF, in which case it is received by the user and stored in his or her mobile RF receiver." *NTP III*, Pet. 6a. The Campana system architecture is a significant step forward, because it allows the user to keep track of electronic mail messages without requiring the user to log in to her email system. *Id.*

2. The Infringing BlackBerry System in the United States

Petitioner RIM markets the infringing BlackBerry system to numerous consumers in the United States. While RIM also markets the BlackBerry system to users outside the United States, this activity is not covered by NTP's complaint and is not part of this suit.

RIM's efforts to sell the infringing system in the United States have been very successful. *See* Pet. 6-7. RIM's boast that the "BlackBerry system has become part of the nation's critical communications infrastructure . . . not only for everyday use, but also in times of crisis," *id.* at 7, is both difficult to reconcile with RIM's position that no "use" occurs within the United States and confirms the commercial success of Campana's innovative marriage of electronic mail with wireless access conceived in 1990.

The infringing BlackBerry system comprises "(1) the BlackBerry handheld unit (also referred to as the 'BlackBerry Pager'); (2) email redirector software (such as the BlackBerry Enterprise Server ('BES'), the Desktop Redirector, or the Internet Redirector); and (3) access to a nationwide wireless network (such as Mobitex, DataTAC, or GPRS)." *NTP III*, Pet. 6a-7a. The function of each component is described in the Federal Circuit's decision. *Id.* at 6a-8a. In brief, the redirector software "merges seamlessly with the user's existing email system," *id.* at 7a, with no modification required. Exactly where this integration takes place depends on the specific redirector software ordered by the customer. Each suite of redirector software, however, accomplishes the same goal—a message coming in to the user's electronic mail box on the user's existing electronic mail system is cloned and then sent "through the BlackBerry Relay, where it is translated and routed from the processors in the user's email system to a partner wireless network." *Id.* at 8a. That RF network "delivers the message to the user's BlackBerry handheld, and the user is notified virtually instantly of new email messages." *Id.* (quotation omitted). In the infringing system, only the Relay is located outside of the United States; it is undisputed that for American customers, the user's electronic mail system, the redirector software, the "nationwide wireless network," the user's handheld device, and the user herself are all in the United States.

3. The Comprehensive Scope of Section 271

Pursuant to its express Constitutional authority "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the

exclusive Right to their respective Writings and Discoveries," U.S. Const. art. I, § 8, Congress has defined a broad set of infringing acts. 35 U.S.C. § 271. The most basic form of liability, direct infringement, is set forth in Section 271(a), which provides that "whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent" is an infringer. *Id.* § 271(a). "It is beyond argument," that the activities identified in subsection (a) are independent and thus "that performance of only *one* of the [now five] enumerated activities is patent infringement." *Roche Prods., Inc. v. Bolar Pharm. Co.*, 733 F.2d 858, 861 (Fed. Cir. 1984).

Sections 271(b) and (c) broaden the scope of who may be liable for the infringement defined in Section 271(a) to "[w]hoever actively induces infringement," 35 U.S.C. § 271(b), and to anyone who imports, sells, or offers to sell within the United States certain non-staple items for use in a patented machine or process, *id.* § 271(c). Section 271(f) imposes liability upon parties who supply components of a patented invention in or from the United States where such components either induce the production of a patented invention or are non-staple goods for use in a patented invention. *Id.* § 271(f). Finally, Section 271(g) imposes liability on anyone who imports, sells, offers to sell, or uses within the United States the product of a process patented in the United States, even if the process is conducted wholly outside the United States. *Id.* § 271(g).

Congress has thereby swept into Section 271 every way in which someone might try to exploit a patented invention in the United States without being licensed to do so. Indeed, Congress has consistently sought to exercise its full power to meet the constitutional command that it secure to inventors the exclusive right to their discoveries. Thus, where judicial decisions have suggested "loopholes" that might allow creative infringers to dodge the application of U.S. patent law, Congress has traditionally acted to fill those gaps. For example, Section 271(f)'s clear bar on supplying components that would be used to make an invention outside the United States responded to this Court's *Deepsouth* decision, which held that supplying in the United States all of the parts necessary to

construct a patented invention did not constitute "mak[ing]" the device within the United States when the actual assembly of those parts occurred outside the Nation's borders. *Deepsouth Packing Co. v. Latraim Corp.*, 406 U.S. 518, 528 (1972).

B. Proceedings Below

1. NTP's Victory in the District Court

NTP filed its complaint against RIM on November 13, 2001, in the U.S. District Court for the Eastern District of Virginia. The complaint alleged that RIM, and its American customers, infringed numerous claims of the patents-in-suit.[3]

The parties filed a series of summary judgment motions. *NTP III*, Pet. 9a. Of relevance to the issue RIM presents in its petition, RIM asked for summary judgment on the theory "that the physical location of the 'Relay' component of the BlackBerry system put RIM's allegedly infringing conduct outside the reach of 35 U.S.C. § 271." *Id.* Specifically, RIM argued "that it cannot be held liable for direct infringement under § 271(a) because it does not practice the entire patented process in the United States, and it does not assemble all of the components necessary for any of the patented systems in the United States." *NTP, Inc. v. Research in Motion, Ltd.*, No. 3:01CV767 (E.D. Va. Aug. 5, 2003) ("*NTP I*"), Pet. 147a. The district court denied all of RIM's summary judgment motions, including its claim that an extraterritorial component precluded a finding of "use" infringement. *Id.* at Pet. 149a; *see also NTP III*, Pet. 9a.[4]

The case went to trial on fourteen claims, all of which were submitted to the jury. *NTP III*, Pet. 10a. On November 21, 2002, the jury found in favor of NTP on each issue presented to it. In particular, the jury rejected every defense propounded by

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[3] The "patents-in-suit" (or "Campana patents") are U.S. Patent Nos. 5,436,960 (the '960 Patent), 5,438,611 (the '611 Patent), 5,625,670 (the '670 Patent), 5,631,946 (the '946 Patent), 5,819,172 (the '172 Patent), 6,067,451 (the '451 Patent), and 6,317,592 (the '592 Patent).

[4] NTP asked the court for partial summary judgment of infringement on four claims of the patents-in-suit. The district court "granted summary judgment [as to the four claims], except as to the issue of infringement of claim 15 of the '960 patent and claim 248 of the '451 patent by the BlackBerry series 5810 handheld device," which issue was reserved for the jury. *NTP III*, Pet. 10a.

RIM, *id.* at 10a-11a, and "found direct, induced, and contributory infringement by RIM on all asserted claims of the patents-in-suit," *id.*, at 10a. The "jury also found that the infringement was willful." *Id.* The district court denied RIM's motions for judgment as a matter of law or for a new trial on May 23, 2003. *Id.* at 11a.

Later, on August 5, 2003, the district court entered final judgment in favor of NTP. The court awarded monetary damages in the total amount of $53,704,322.69, representing the following approximate amounts: (1) compensatory damages of $33 million; (2) attorneys' fees of $4 million; (3) prejudgment interest of $2 million; and (4) enhanced damages of $14 million. *NTP I*, Pet. 137a-38a (Final Order). The district court also granted NTP's motion for a permanent injunction enjoining RIM from making, using, offering to sell, or selling within the U.S. or importing into the U.S. any of the accused BlackBerry systems, software, and handhelds. *Id.* at 138a-39a. The district court stayed the injunction pending appeal. *Id.* at 140a.

2. NTP's Victory in the Federal Circuit

On December 14, 2004, the U.S. Court of Appeals for the Federal Circuit affirmed the district court's construction of all claim terms, with one exception not relevant here. *NTP, Inc. v. Research In Motion, Ltd.*, 392 F.3d 1336 (Fed. Cir. 2004) ("*NTP II*"), Pet. 79a. The unanimous panel also "conclude[d] that the district court correctly found infringement under 35 U.S.C. § 271(a), correctly denied RIM's motion for judgment as a matter of law . . . , and did not abuse its discretion in denying evidentiary motions," and remanded for further proceedings. *Id.* at 79a-80a.

As to the Section 271(a) issue specifically, the Federal Circuit properly recognized that "[t]he territorial reach of a patent right is limited, so that section 271(a) is only actionable against patent infringement that occurs within the United States." *Id.* at 124a-25a. It then explained that "[t]he plain language of section 271(a) does not preclude infringement where a system such as RIM's, alleged to infringe a system or method claim, is used within the United States even though a component of that system is physically located outside the

United States." *Id.* at 128a. "For th[at] reason[]," it went on, "we conclude that when two domestic users communicate via their BlackBerry devices, their use of the BlackBerry system occurs 'within the United States,' regardless of whether the messages exchanged between them may be transmitted outside of the United States at some point along their wireless journey." *Id.*

Relying on the Court of Claims' decision in *Decca Ltd. v. United States*, 544 F.2d 1070 (Ct. Cl. 1976), the Federal Circuit distinguished RIM's customers' infringement from that at issue in *Deepsouth Packing Co. v. Laitram Corp.*, 406 U.S. 518 (1972). *NTP II*, Pet. 129a-31a. As in *Decca*, "'the *location* of the infringement," here RIM's customers' infringement, "is within United States territory, not abroad as in *Deepsouth*.'" *Id.* at 130a (quoting *Decca*, 544 F.2d at 1074). Because it affirmed the district court's decision under the "use" prong of Section 271(a), the court "d[id] not consider the parties' respective arguments under" subsection (f) or (g), or under the "sale" or "offering for sale" prongs of subsection (a). *Id.* at 125a.

On August 2, 2005, the Federal Circuit granted RIM's petition for panel rehearing "for the limited purpose of revising portions of the opinion treating Section 271." Pet. 76a. In its renewed lengthier discussion of the issue, the Federal Circuit *reaffirmed* that "*Deepsouth* did not address the issue" at bar and that its predecessor court's decision in *Decca* "provides a legal framework for analyzing this case." *NTP III*, Pet. 53a-54a. It also clarified that RIM's Section 271(a) argument did not affect six of the patent claims at issue in the case. *Id.* at 50a; *see infra* Part III.F. The Federal Circuit denied RIM's petition to hear the case *en banc*.

As it had previously, the Federal Circuit determined that RIM's customers' infringement of the patented BlackBerry system was legally indistinguishable from the United States' infringement of Decca's patented Omega satellite system. *Id.* at 55a-56a. Because "[w]hen RIM's United States customers send and receive messages by manipulating the handheld devices in their possession in the United States, the location of the use of the communication system as a whole occurs in the United States," "the jury was properly presented with

questions of infringement as to NTP's system claims containing the 'interface' or 'interface switch' limitation," which limitation is met with RIM's Relay component. *Id.*

The Federal Circuit, thus, reaffirmed that RIM's customers in the United States "use" the patented BlackBerry *system* "within the United States." The only substantive alteration it made to its decision in *NTP II* was to differentiate RIM's customers' infringement of NTP's method claims under the territorial limitation of Section 271(a). *Id.* at 56a-58a.[5] That issue is not before this Court.

3. The Ongoing Proceedings in the District Court

On October 21, 2005, the Federal Circuit denied RIM's motion to stay issuance of the Federal Circuit's mandate. On October 26, 2005, Chief Justice Roberts, acting as Circuit Justice for the Federal Circuit, also denied any stay of the court of appeals' mandate. On November 30, 2005, the district court denied RIM's motion to enforce a purported settlement agreement reached between the parties and to dismiss the case as moot.[6] Thus, the case has been fully remanded and is currently going forward "on the remaining issues relating to NTP's request for injunctive relief and appropriate damages." Order, *NTP, Inc. v. Research in Motion, Ltd.*, No. 3:01CV767-JRS (E.D. Va. Dec. 16, 2005), *infra* 26a. The district court has set a briefing schedule for these remedial issues. Legal questions regarding the scope and availability of injunctive relief were

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[5] Acknowledging that the *Decca* court also distinguished between the systems and methods claims at issue in that case, *NTP III*, Pet. 54a-55a, the Federal Circuit reasoned that, "[u]nder section 271(a), the concept of 'use' of a patented method or process is fundamentally different from the use of a patented system or device," *id.* at 56a. It explained: "Because a process is nothing more than the sequence of actions of which it is comprised, the use of a process necessarily involves doing or performing each of the steps recited." *Id.* at 57a. According to the court, "[t]his is unlike use of a system as a whole, in which the components are used collectively, not individually," or a customer can, with one action or step, call into service the entire system. *Id.* The court therefore held "that a *process* cannot be used 'within' the United States as required by section 271(a) unless each of the steps is performed within this country." *Id.* (emphasis added).

[6] As explained *infra*, Part III.A, RIM has not disavowed any intention to appeal the district court's decision that this case is not moot.

not previously presented to the Federal Circuit, are not presented in RIM's petition, and are not ripe for this Court's review. They remain to be decided by the district court.

REASONS FOR DENYING THE PETITION

I. The Federal Circuit Did Not Err in Applying Well-Established Precedent to the Facts of this Case.

First and foremost, this Court should deny RIM's petition because the Federal Circuit, the appellate court with exclusive jurisdiction over patent appeals, correctly applied Section 271(a) and binding circuit precedent—which Congress has reaffirmed—to the facts of this case.

A. The Federal Circuit Properly Read the Statute and Applied Long-Standing Precedent to the Facts of this Case.

Despite RIM's rhetorical promise of a "landmark intellectual property case," posing a "cutting-edge question" in the "Internet Age," and its repeated italicization of the word "*transnational*," *e.g.*, Pet. 2, there is simply nothing new or difficult about the application of Section 271(a) to the facts of this case. NTP does *not* claim damages for infringement by RIM's customers located outside of the United States. The only territorial question presented and addressed by the Federal Circuit was whether "use ... within the United States" of the BlackBerry system could occur where millions of email messages are originated and sent to BlackBerry customers every day, where the BlackBerry user uses the system to send and receive email, and where the email systems, redirector software, RF networks, and handheld units are located. On this narrow question, the unanimous panel below properly read Section 271(a) and applied long-standing precedent to reach the unremarkable conclusion that RIM's American customers "use" the BlackBerry system within the United States. Any other result would create a rule of law that would reward geographic gamesmanship and evasion of United States patent protections that is fundamentally inconsistent with the text and history of Section 271(a) itself.

1. The Only Issue Arguably Preserved on Appeal and Presented in RIM's Petition Is Whether RIM's American Customers Use the BlackBerry System Within the United States.

As explained above, RIM has never appealed the jury's finding that *its* activities with respect to the infringing BlackBerry system constitute contributory and inducement infringement, as long as its customers in the United States are direct infringers under Section 271(a). RIM also did not appeal "the jury's finding that its customers use, *i.e.*, put into service, its systems and methods for transmitting email messages." *NTP III*, Pet. 51a; *see id.* at 56a n.13. "RIM *only* appeals whether such use occurs within the United States, in light of the location of the Relay within Canada." *Id.* at 56a n.13 (emphasis added).

RIM only appealed the narrow finding that *its American customers* were direct infringers under section 271(a), which states:

> Except as otherwise provided in this title, *whoever without authority* makes, *uses*, offers to sell, or sells *any patented invention, within the United States* or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.

35 U.S.C. § 271(a) (emphases added).

As explained below, the language of Section 271(a), long-standing precedent, and commonsense all point in the same direction – decidedly against RIM's attempt to engraft a new territorial loophole into subsection (a) such that the placement of any component of a patented system outside of the United States would preclude its "use," by anyone, being "within the United States."

2. The Federal Circuit Properly Construed the Term "Use" Consistent with its Plain Meaning and this Court's Precedent.

For its understanding of the statutory term "use," the Federal Circuit relied on the term's plain meaning and long-standing Supreme Court precedent. Specifically, the court below reiterated this Court's pronouncement, more than 90 years ago, that "'use,' as used in a predecessor to title 35, is a

'comprehensive term and embraces within its meaning the right *to put into service* any given invention.'" *NTP III*, Pet. 55a (quoting *Bauer & Cie v. O'Donnell*, 229 U.S. 1, 11 (1913)) (emphasis added). It further explained that:

> The ordinary meaning of "use" is to "put into action or service." *Webster's Third New International Dictionary* 2523 (1993). The few court decisions that address the meaning of "use" have consistently followed the Supreme Court's lead in giving the term a broad interpretation.

Id. (citing case law). Relying on the plain meaning and this Court's broad construction of the word "use," then, the Federal Circuit further clarified that "[t]he use of a claimed system under section 271(a) is the place at which the system as a whole is put into service, *i.e.*, the place where control of the system is exercised and beneficial use of the system obtained." *Id.* (citing *Decca*, 544 F.2d at 1083).

This understanding merely restates what the U.S. Court of Claims held in *Decca* nearly three decades ago, a case in which this Court denied *certiorari* and that is still binding in the Federal Circuit and therefore on all patent appeals. The Federal Circuit's recitation of the facts and holding of *Decca* cannot be improved upon.

> In *Decca* . . . [t]he claimed invention was a radio navigation system requiring stations transmitting signals that are received by a receiver, which then calculates position by the time difference in the signals. At the time of the suit, the United States was operating three such transmitting stations, one of which was located in Norway and thus was outside the territorial limits of the United States . . . [I]n considering infringement of [the claim requiring three transmitting stations], the court considered the extraterritorial reach of the patent laws as applied to a system in which a component was located outside the United States. . . .[T]he court reached no clear resolution of whether the accused system was 'made' within the United States. Nevertheless, the court said, "Analyzed

> from the standpoint of a *use* instead of a *making* by the United States, a somewhat clearer picture emerges." The court concluded that "it is obvious that, although the Norwegian station is located on Norwegian soil, a navigator employing signals from that station is, in fact, '*using*' that station and *such use occurs wherever the signals are received and used in the manner claimed.*" . . . . [T]he court found particularly significant "the ownership of the equipment by the United States, the control of the equipment from the United States and . . . the actual beneficial use of the system within the United States."

NTP III, Pet. 53a-54a. (emphasis added) (citations omitted).

As this lengthy exposition of the applicable precedent makes abundantly clear, the Federal Circuit broke no new legal ground in articulating the proper understanding of the statutory term "use," and the place where a "transnational system" is "used." The Federal Circuit's conclusion that the location of a system component abroad does not preclude as a matter of law a finding of direct infringement under the "use" prong of Section 271(a) was compelled by binding precedent. *Id.* at 56a. There could be no question before the Federal Circuit's decision in *NTP III*, and there can be no question after, that an infringer "uses" a patented system where the system as a whole is put into service, and that it is put into service where control of the system is exercised and the beneficial use of the system is obtained.

The Federal Circuit also considered this Court's decision in *Deepsouth*, upon which RIM relied heavily below, *NTP III*, Pet. 51a-52a, and properly concluded that, as was the case in *Decca*, *Deepsouth* does not speak to the issue in this case, *id.* at 53a-54a. In *Deepsouth*, the "sale" and "use" of the patented product occurred entirely outside the United States. Instead, addressing the "make" prong of Section 271(a), the patent holder attempted to extend the words of the statute by arguing that, even though the actual assembly or "making" of the patented invention took place wholly outside the United States, the fact that the components were supplied in the

United States demonstrated infringement under the "make" prong. This Court rightly rejected that attenuated reading. In RIM's case, by contrast, the issue is not where the BlackBerry system was assembled, but where the alleged direct infringers—its American customers—"use" a patented invention. Thus, both the *Decca* court and the Federal Circuit below properly "[a]nalyzed" the issue "from the standpoint of a use instead of a making," *NTP III*, Pet. 54a (quoting *Decca*, 544 F.2d at 1082), and readily distinguished *Deepsouth*.

3. The Federal Circuit Properly Applied the Established Legal Understanding of the Term "Use" to the Facts of this Case.

It is impossible to imagine how the Federal Circuit could have applied the meaning of "use" articulated by this Court in 1913 and further clarified in *Decca* to the facts of NTP's claims and RIM's American customers' infringement *without* reaching the conclusion it did—that direct infringement under § 271(a) occurred when RIM's American customers "used" the BlackBerry system within the United States. In the terms used by the court below, "[t]he technology at issue relates to systems for integrating existing electronic mail systems . . . with radio frequency wireless communication networks, *to enable a mobile user to receive email over a wireless network.*" *NTP III*, Pet. 3a. (emphasis added).

RIM never disputed that, for its American customers, the message originates in the United States in an electronic mail system located in the United States, is transmitted from RF stations in the United States, and is received by the user on his or her mobile handheld unit in the United States. With these undisputed facts established, the Federal Circuit necessarily concluded that "RIM's customers located within the United States controlled the transmission of the originated information and also benefited from such an exchange of information." *NTP III*, Pet. 56a. Indeed, the Federal Circuit could not have found that the court below was precluded from finding that RIM's American customers had "used" the BlackBerry system "within the United States" *without overruling Decca.*

Nor could the Federal Circuit have reached any other conclusion without defying common sense. There is simply no question that the typical BlackBerry user in Lafayette Park, or standing in line outside the Maryland Avenue entrance to the Court, "uses" the patented invention "within the United States." In the infringing use for which liability was established, a sender types an email on an originating processor in a K Street office. The email travels to a K Street-located email gateway server/BlackBerry redirection software and then through U.S.-based wirelines briefly to the Relay where it is passively relayed to a U.S.-located wireless network. The U.S. located network then sends the email to a D.C. radio tower. The BlackBerry user stands in Lafayette Park or on Maryland Avenue, receives the email on a BlackBerry device and employs the device to view and manipulate the email. RIM has never successfully attacked the common sense conclusion of the district court and the Federal Circuit that such use occurs "within the United States."

B. None of RIM's Oblique Attacks on the Federal Circuit's Reasoning Is Persuasive.

RIM does not, nor could it, offer an alternative definition and formulation of "use" that follows this Court's nearly century old construction, respects the term's plain meaning, as well as common sense, *and* excludes its American customers' conduct from the application of Section 271(a). This observation alone speaks volumes about the weakness of RIM's position, a conclusion in search of a theory. In the fewer than eight pages it uses to attack the Federal Circuit's application of established law to the facts of this case, RIM makes a series of oftentimes circular arguments that, at their worst, advocate judicial rewriting of Section 271(a) and, at their best, say nothing.

1. Through a poorly executed slight of hand, RIM suggests that it is focusing on the meaning of the word "within," Pet. 23-24, when it is in fact attempting to rewrite the territorial requirement and remove the words "use" and "whoever" from the statute.

First, RIM's statutory "reconstruction" conflates conduct (the "use") with the "patented invention" itself. *Id.* In this way,

RIM refuses to accept the negative implication of the express terms of the territorial limitation – that subsection (a) *does not* require that the entire "patented invention" or even a substantial component reside "within the United States." In fact, RIM ignores completely that Section 271(a) *as written* fully contemplates that the "situs of an . . . accused invention" may be different from, or more difficult to ascertain than, the "situs of its use," *id.*, and requires only that the latter be within the United States. Thus, by arguing that the entire BlackBerry system must be "within the United States," RIM asks this Court to apply the territorial limitation to the situs of the infringing system, making its location dispositive on the territorial question and removing "use" from the statute altogether.[7]

Second, RIM would have this Court read the terms "whoever" and "use" out of subsection (a) entirely by making the relevant inquiry where *RIM* asserts it "made" the BlackBerry system and not where its *customers'* "use" the system Pet. 24. That is, by focusing on where RIM chose to place the Relay when it "made" the system, *e.g.*, *id.* ("the system's accused [Relay] is located in Canada"), RIM fails *both* to acknowledge that subsection (a) reaches "whoever" "uses" the patented invention, even if it is someone other than the person or entity that "makes," "offers to sell," or "sells" the patented invention, *and* to comprehend that the act of "making" or assembling the system is distinct from the statutorily independent act of "using" the system.[8] Such a

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[7] Unable to couch its argument in terms of the statute, RIM poses the rhetorical question: "How can a system that is not located 'within the United States,' i.e., not entirely inside the bounds or limits of, and not enclosed, contained, or confined by, the United States, be 'used . . . *within* the United States' . . . ?" Pet. 23. The answer is as plain as the infringement in this case: it can be used within the United States *at least* where a system is made available for use by customers located in the United States. *NTP III*, Pet. 55a.

[8] As further evidence that RIM does not recognize any difference between "make" and "use" infringement, RIM asserts: "[s]ince 'making' an invention requires all components of a system to be located 'within the United States' for infringement under § 271(a), it follows that 'use' infringement also requires all components of an invention (i.e., system) to

(Cont'd)

reading of the statute would not only violate the "'cardinal principle of statutory construction'" that each word should be given meaning, *Bennett v. Spear*, 520 U.S. 154, 173 (1997), but also fundamentally alter U.S. patent law, as explained below, *see infra* Part II.

Third, RIM attempts to reopen an issue *it conceded on appeal*, *NTP III*, Pet. 51a, 56a n.13 – that its customers "put into service" the BlackBerry system. This is because there are only two ways to interpret RIM's recitation of the Lafayette Park hypothetical, where it attempts to distinguish between the subscriber using the handheld device and using the entire BlackBerry system. Pet. 24. *Either* RIM accepts the jury's finding that its subscribers put into service the BlackBerry *system* as a whole and believes that the subscriber is metaphysically transported outside of the United States during some moment of the subscribers' use, a proposition that, for obvious reasons, RIM does not openly embrace. *Or* RIM simply does not accept that its subscribers *ever* put into service the BlackBerry system as a whole, a proposition that *it did not dispute in the Federal Circuit. E.g.*, *NTP III*, Pet. 51a; *id.* at 56a n.13 (RIM did not appeal "the jury's finding that its customers use, *i.e.*, put into service, its systems and methods for transmitting email messages").

2. RIM also asserts that the "beneficial use" and "control" formulation, clarified in *Decca* and recited by the Federal Circuit in *NTP III*, "imports into the plain text of § 271(a) a new principle" that is sure to "confound district courts." Pet. 25-30.[9]

(Cont'd)

be located 'within the United States,' *regardless* of the situs of 'control or beneficial use' of the system." Pet. 24 n.10. This statement begs the question "why," fails to acknowledge the difference in the nature of "make" and "use," and assumes that it is the situs of the patented invention and not the use that is relevant to the territorial inquiry.

[9] RIM also suggests that the Federal Circuit's distinction between the "use of method" and "use of system" claims in this case is somehow unworkable and illusory. Pet. 24-25. To be clear, RIM cannot, and NTP does not, appeal the lower court's ruling that the patented method was not "used" "within the United States." Although NTP believes that the use of both types of patented inventions occurred within the United States under the facts of this case, the line drawn by the Federal Circuit is by no means unknown in patent law, *NTP III*, Pet. 56a-57a (citing cases distinguishing between method and system claims).

This formulation is not new, does not expand the plain text, and has confounded no courts in the nearly 30 years since it was clarified in *Decca*.

First, as *RIM quotes in its petition*, the *NTP III* panel used precisely the same formulation as did the court in *Decca* to discern the situs of infringing use—"*control* of the equipment from the United States" and "the actual *beneficial use* of the system within the United States," Pet. 27 (quoting *Decca*, 544 F.2d at 1083 (emphases added)). Nor does the fact that *Decca* "arose under 28 U.S.C. § 1498," as RIM observes, *id.* at 26, render the formulation new. As the Federal Circuit explained, although *Decca* was decided in the context of the statutory provision addressing infringement "*by* the United States," 28 U.S.C. § 1498, "the question of use *within* the United States also was implicated because direct infringement under section 271(a) is a necessary predicate for government liability under section 1498." *NTP III*, Pet. 54a. In the language of the *Decca* court, "[t]he question thus presented [wa]s whether the system of claim 11 has been made or *used, as those terms are employed in the patent law*, by or for the United States." 544 F.2d at 1082 (emphasis added). The *Decca* case thus also arose under Section 271.

Second, the "control" and "beneficial use" formulation is not a "revision to the statute's text." Pet. 26. RIM does not dispute that the plain meaning of "use" is "to put into service." *NTP III*, Pet. 55a. As the Federal Circuit explained, the "control" and "beneficial use" factors are simply ways for the courts to ascertain *where* the patented invention is *put into service*, *id.*, an inquiry dictated by the "use" and "within the United States" requirements of the statute. Far from being an expansion of the text, the *Decca* formulation, if anything, *constricts* the full reach of "use" by limiting it to only certain types of "use," where there is real control or actual beneficial use, and/or putting the system as a whole into service.

Finally, RIM produces no decisions in which a lower court struggled with, and was unable to apply, the "control" and "beneficial use" formulation as announced in *Decca* nearly three decades ago. Although its application will necessarily

depend on the patent claim at issue and the facts of the case, this is hardly an indictment; it is what courts do.

C. The Federal Circuit's Decision Raises No Separation of Power Concerns.

Apparently conceding that *Deepsouth* is not controlling in this case, *compare NTP III*, Pet. 52a-53a (observing that "RIM argues that *Deepsouth* answers th[e] question"), *with* Pet. 2 (characterizing question presented as one "the Court did not address when it decided *Deepsouth*"), RIM dedicates five pages of its petition and its discussion of *Deepsouth* to the unremarkable proposition that federal courts should not misconstrue the patent laws or apply Section 271(a) beyond its terms to reach extraterritorial conduct. *Id.* at 18-22. NTP does not dispute that *if* there were a territorial loophole into which RIM's American customers' activity falls, "*only Congress*, and not the courts, could fix it." Pet. 19. Restatement of this axiom merely begs the question in this case, namely, whether Congress, in Section 271(a), reached the conduct at issue here.[10]

The Federal Circuit determined that it did. Moreover, if there were ever any question that the test announced in *Decca* (and applied here) properly construed and captured

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[10] Nor does NTP dispute that "*only Congress* can give the patent infringement provisions extraterritorial effect." Pet. 22. Nonetheless, RIM's reliance on the presumption against extraterritoriality is simultaneously misplaced and unavailing. *Id.* at 21. Section 271(a) itself circumscribes actionable infringement to "uses . . . within the United States," 35 U.S.C. § 271(a), a point the Federal Circuit fully understood, *NTP III*, Pet. 48a-49a. Because the territorial limit of the statute is unambiguously set by its plain language, there is no occasion to reach for presumptions or other canons of construction to assist in its interpretation. *See EEOC v. Arabian Am. Oil Co.*, 499 U.S. 244, 248 (1991) (the presumption against extraterritoriality "'is a valid approach whereby *unexpressed* congressional intent may be ascertained'" (quoting *Foley Bros., Inc. v. Filardo*, 336 U.S. 281, 285 (1949)) (emphasis added)). Nor has NTP sought any extraterritorial application of Section 271(a). NTP sought relief only for commercial exploitation of BlackBerry users located in the United States, as the Federal Circuit properly understood. *NTP III*, Pet. 56a (limiting the court's holding to "RIM's customers *located within the United States*" (emphasis added)).

Congress's intent in Section 271(a), that question evaporated in the nearly three decades since the case was decided, as Congress has never acted to "correct" the *Decca* court's understanding of the statute.[11] Indeed, Congress's knowledge of *Decca* need not be presumed here. Congress has actively discussed and analyzed the decision in *Decca* and condemned the portion of *Decca* wherein the court refused to read 35 U.S.C. § 271 as reaching U.S. ships. H. R. Rep. No. 101-960 (1990); S. Rep. No. 101-266 (1990), *reprinted in* 1990 U.S.C.C.A.N. 4058. Congress thus clearly understood *Decca*'s holdings and chided the court for not going far enough. To the extent any "serious separation of powers concerns" are implicated in this case, Pet. 20, it is a *reversal* of the Federal Circuit's decision, and unsettling of decades-old precedent of which Congress is well aware, that would raise these concerns.[12]

II. Contrary to RIM's Suggestion, It Is a *Reversal* of the Federal Circuit's Decision that Would Wreak Havoc on Existing Patents for Computer-Based Systems and Undermine International Patent Treaties.

As explained in Part III, *infra*, reversal of the Federal Circuit's decision would have little or no impact on the present case or the future of the BlackBerry system in the United States. Adoption of the strained reading of "use" put forth by RIM in its petition would, however, have far-reaching negative effects on all computer-based inventions. RIM's conception of limitations on national jurisdiction would establish an international dead zone where *no* nation's laws could extend, and in one stroke create a quick

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[11] *See, e.g., Herman & MacLean v. Huddleston*, 459 U.S. 375, 385-86 (1983) ("In light of [a] well-established judicial interpretation [of a statutory provision], Congress' decision to leave [the provision] intact suggests that Congress ratified" the interpretation).

[12] As explained above, *see supra* at pp. 6-7, Congress has never been shy about reacting to patent law interpretations with which it disagrees.

and easy method for infringing entities to skirt *all* national patent laws.

A. RIM's Position Would Gut The Effectiveness of U.S. Patent Law.

RIM urges this Court to find that any time even one component of an infringing system is located outside the United States, it insulates from liability anyone who uses it in the United States. Pet. 16. Such a ruling would serve as a clear roadmap for every infringer (contributory, inducing, and direct) and potential infringer on how to evade U.S. patent liability for electronic systems. All the infringer would need to do is move one component offshore and claim immunity as a "*transnational*" entity. In these days of nearly instantaneous global communication, designing an infringing system to incorporate components in more than one country would be a trivial undertaking.

RIM's interpretation of Section 271(a) would have dramatic and pernicious effects. As Microsoft observed in its *amicus* brief below, "[h]ad RIM's counter-argument prevailed . . . it would have created an incentive for American companies to locate certain aspects of their systems outside the United States, *primarily to avoid infringement liability*. Such an outcome *would likely result in loss of jobs, skilled workers, capital, and information technology,* abroad." Br. of Amicus Curiae Microsoft Corp. at 9, No. 03-1615 (Fed. Cir. filed Aug. 24, 2005) (emphasis added). This easy circumvention of patent protection can hardly be what Congress had in mind when it created the comprehensive protections contained in Section 271. The Federal Circuit correctly rejected RIM's invitation to throw open the gates of wholesale patent infringement to every company with a high-speed international data connection, and RIM has provided this Court with no reason to revisit that decision.

B. It Is RIM's Flawed Reading of the Statute that Would Conflict with International Law.

RIM suggests in passing that that the Federal Circuit's decision "runs head-on into multi-lateral treaty obligations (*e.g.*, the TRIPS Agreement on intellectual property rights) that are predicated on national, not extraterritorial, application of signatories' (including Canada's) patent laws." Pet. 20-21. However, RIM has never been able to provide any example of an actual conflict between the Federal Circuit's decision and specific "multi-lateral treaty obligations."

Indeed, multilateral patent treaties, by design, recognize each country's right to protect inventorship within its own borders. Contrary to RIM's circular supposition that the court below offended this design by reaching activity beyond the territorial United States, as explained above, the Federal Circuit merely affirmed the finding that RIM's customers' activities *within the United States* constitute use sufficient for a finding of infringement under Section 271(a). Far from offending other nations' notions of patent jurisdiction, the Federal Circuit's decision precisely tracks that reached by the only other legal system to address the issue.

In *Menashe Business Mercantile, Ltd. v. William Hill Org., Ltd.*, [2002] EWCA Civ 1702, [2003] All E.R. 279 (C.A. 2002), the United Kingdom Court of Appeal reached a conclusion identical to that reached by the Federal Circuit. In that case, the court considered the location of "use" under a European Patent, using a virtually identical definition of that term as the one employed by the Federal Circuit ("to put the invention into effect.") The U.K. court found that "use" includes the customer's locale because the customer "will use the claimed gaming system in the United Kingdom, even if the host computer is situated in, say, Antigua." *Id.* ¶ 33. Focusing on the location of individual components of the system would be a mistake because "[i]t is of no relevance to him, the user, nor the patentee as to whether

or not [the host computer] is situated in the United Kingdom." *Id.* ¶ 32. After being apprised of *Menashe*, even the government of Canada has now acknowledged that "national jurisdiction over trans-border technology may be justifiable under internationally accepted theories of national jurisdiction." Br. of Amicus Curiae Government of Canada at 3-4, No. 03-1615 (Fed. Cir. Aug. 16, 2005).

Indeed, it is RIM's skewed interpretation of the reach of national jurisdiction that jeopardizes the ability of *any* nation to enforce its own patent laws. Fundamentally, the purpose of international intellectual property agreements is to *safeguard* patent rights. Because RIM's reading of the statute would allow a new class of transnational pirates to copy a system in every respect but avoid patent liability by siting one component of that system in a different country, this interpretation would create a lawless "no man's land" in which neither the United States *nor any other country could exercise jurisdiction*. Such a result would call into question the effectiveness of every national patent system.

III. This Case Is a Poor Vehicle for this Court's Review of the Question Presented.

Even assuming that the question presented in RIM's petition were otherwise worthy of this Court's review, this case would be a poor vehicle for addressing that question.

A. RIM *Continues To Contend* that this Court Lacks Jurisdiction To Hear this Case.

First and foremost, RIM's petition fails to alert this Court that its *current* position in the courts below, on remand from the Federal Circuit's decision, is that the federal courts lack jurisdiction to hear *any portion of* this case. Pet. 10 n.3 (stating elliptically in a footnote that "the district court denied RIM's motion to enforce a previously announced settlement agreement"). It has taken this position – that a purported settlement reached between the parties has rendered this case moot and ousted the courts of jurisdiction – in its Federal Circuit Motion to Stay Appeal

and Remand for Enforcement of Settlement ("Remand Mot."), *infra* at 1a; in public statements, and even in its Federal Circuit motion to stay the mandate. Although the district court has now denied RIM's motion to enforce the settlement, RIM has not disavowed that it will appeal that ruling to the Federal Circuit.[13]

NTP disputes the enforceability of RIM's mischaracterized version of the purported settlement. As RIM represented in its Remand Motion, however, "[i]f the parties' Term Sheet constitutes a binding and enforceable agreement, the underlying case (including this appeal) is moot." *Id.* at 3a. "If moot, then the courts have *no constitutional authority* after March 13 [2005] to continue on the merits of the settled action." Remand Reply, at 13a (emphasis added). Where, as here, a petitioner is simultaneously asserting a lack of jurisdiction based on mootness, *certiorari* is unjustified. *Cf. Barthuli v. Bd. of Trustees*, 434 U.S. 1337, 1339 (1977) (Rehnquist, J.) ("Given the Art. III limitation of our jurisdiction to 'Cases' and 'Controversies,' . . . [a] stay . . . in these circumstances would amount to nothing more than 'a mere declaration in the air.'"). There is simply no reason for this Court to risk expending its and the parties' resources to address the question presented when the petitioner *itself* is representing to the courts below that this case is moot.

B. The Question Presented Does Not Apply to the Facts of this Case.

RIM characterizes this case as one involving "an Internet-based global telecommunications system," Pet. (i), "present[ing] the Internet Age question of how" Section 271(a) "should be applied to geographically borderless, '*transnational*' telecommunications systems," *id.* at 2. Despite RIM's use of generic rhetoric and efforts to wrap itself in

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[13] For purposes of addressing the issue in this opposition, NTP asked RIM to clarify whether it had abandoned the settlement issue and would not appeal the district court's ruling. *See* Letter from J. Wallace to H. Fenster, *et al.* (Dec. 14, 2005), at 24a. RIM did not respond.

the "worldwide, geographically borderless Internet," *id.* at 11, this is not such a case.

The claimed system that BlackBerry users infringe is not "an Internet-based global telecommunications system." The claimed system at issue does not require any use of the internet. It requires only the point-to-point transmission of electronic mail, which could take place over any medium. As Mr. Campana envisioned one embodiment of its design, the transmission could occur over the telephone lines. RIM, itself, has used dedicated lines to transmit data from the Relay to U.S.-based carriers.

That RIM has also chosen to use an internet protocol to transmit information to and from the interface in Canada does not change the nature of the infringed Campana system and NTP's claims.[14] RIM's American customers' ongoing and continued use of its system implicates none of the considerations of the ubiquity of the worldwide web that RIM (incorrectly) believes would, if actually presented, raise difficult questions under the "use" prong of section 271(a).[15]

If the application of Section 271(a) to truly "Internet-based telecommunications, e-commerce, and other systems whose operation *depends* upon computer servers or other major components located in Canada, Western Europe, Asia, or elsewhere," Pet. 12 (emphasis added), does become

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[14] Nor is RIM, for example, a purveyor of goods over the Internet where its sole contact with its customers is a one-time sale. Thus, the issue at bar does not present the question of the "sale" prong's applicability to a one-time purchase of goods from a foreign-based internet website.

[15] Indeed, *Decca* itself comes closer to presenting the question of how to apply Section 271(a) to a system that, by its nature, must be global and extend beyond the territorial borders of the United States than does *NTP III*, where the BlackBerry system could function precisely as it was designed to without placing a single component outside of the United States. *Decca*, 544 F.2d at 1074 ("Of its very nature the [radiolocation] system cannot be confined to one country."). This Court was nonetheless untroubled by the application of Section 271(a) to the use of a system that was necessarily "geographically borderless." *Decca Ltd. v. United States*, 454 U.S. 819 (1981) (denying *certiorari*).

difficult, *Congress* would undoubtedly be in the best position to reconsider its "decades-old" territorial limitation in light of this technology. And even if this Court, as RIM presumes, were interested in reconsidering long-standing precedent—not because it is incorrect, but solely because it is applied to such "geographically borderless" systems—then the proper course would be for this Court to wait until a case that actually involves such a system is presented.

C. Even if the Decision Below Were Read To Break Some New Legal Ground, Review Should Await Further Examination of These Issues by the Federal Circuit and the Federal District Courts.

Even if the Federal Circuit's application of *Decca*'s test to the facts of RIM's American customers' infringement could somehow be characterized as "cutting-edge," this novelty would counsel *against granting* RIM's petition and *in favor of waiting* to see how the *NTP III* decision will be applied by the district courts and how the Federal Circuit responds as the issue percolates in the district courts throughout the United States in other varying factual contexts. As this Court has recognized, the Federal Circuit, by congressional design, is uniquely situated to interpret and apply the U.S. patent laws in an expert and uniform manner. *See, e.g., Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 40 (1997) ("We expect that the Federal Circuit will refine the formulation of the test for equivalence in the orderly course of case-by-case determinations, and we leave such refinement to that court's sound judgment in this area of its special expertise."). Accordingly, there is simply no reason to second guess the Federal Circuit on the ground that the federal district courts *may* misapply its decisions.

D. RIM Has Changed Its Position Throughout this Litigation and Presents Newly Minted Legal Arguments to this Court.

RIM's theory of the sliver of the case it now presents to this Court has mutated at every step of this litigation. Its presentation of this latest version of its position to this Court

raises serious questions of waiver. At a fundamental level, and as explained above, *see supra* at p. 16, it appears from RIM's description of the "Lafayette Park example" that RIM now implicitly questions whether RIM's customers can *ever* use the BlackBerry system, and not merely the handheld device, as a whole. Pet. 24. This directly contradicts its position below, as understood by the Federal Circuit, that it was not challenging the jury's finding that "its customers use, *i.e.*, put into service, *its systems*." *NTP III*, Pet. 51a (emphasis added).[16]

Similarly, RIM has lurched from position to position on the import and holdings of *Decca*. In the district court, RIM asserted that *Decca* applied to and supported its noninfringement position. In its opening and reply briefs to the Federal Circuit, RIM again asserted that *Decca* applied. Only in its petitions for rehearing did RIM raise its new interpretation of *Decca* as applying only to 28 U.S.C. § 1498. Now in its petition before this Court, RIM tries another argument that the consent of a foreign government is necessary for U.S. jurisdiction. Pet. 27 n.11.[17]

Not only would consideration of these newly (if only partially) formed positions place this Court in the awkward position of evaluating a Federal Circuit decision based on a different presentation of the case, but this Court could have no confidence that the position RIM takes in its petition would be the position it would present in merits briefing. If the question is as important as RIM suggests, another case will presumably surface that would provide this Court (and the Federal Circuit and opposing counsel) with the same question without the moving-target approach RIM has taken.

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[16] RIM's refusal to acknowledge or address even the most basic facts and legal rulings below composed a pattern the district court described as one of RIM's many "questionable litigation tactics" when it awarded enhanced damages and attorney fees to NTP. *NTP v. Research in Motion, Ltd*, 270 F. Supp. 2d 751 (E.D. Va. 2003).

[17] RIM's reliance on *Deepsouth* has also changed dramatically, as what it once considered dispositive, it now cites for the general proposition that federal courts should not expand the territorial reach of U.S. patent laws beyond what Congress intended. *See infra* Part I.C.

E. There Are Numerous Alternative Grounds for Affirmance of the Federal Circuit's Decision.

Because it determined that RIM's customers in the United States "use" the BlackBerry system "within the United States," the Federal Circuit did not also need to consider the alternative grounds under which the finding of infringement on the specific claims at issue could be affirmed. There is little doubt that RIM infringed the patents under these alternative theories. For example, RIM infringes under the Section 271(a) "sale" prong as RIM indisputably consummated over $2 billion of sale transactions of infringing products and services within the United States. *E.g.*, Morrison Decl. ¶¶ 10, 13, 14, 17 (RIM declarant admitting that RIM is "*selling* its handhelds, software and services *in the United States*" (emphases added))(Ex. 5 to RIM's Application for Stay and Recall of the Federal Circuit's Mandate, No. 05-A-357 (Oct. 24, 2005)). Moreover, Section 271(f) fully backstops Section 271(a) for any systems claims in which some portion is located outside of the United States. This is simply not a case where this Court's reconsideration would have any ultimate effect on the adjudication of rights or relief between the parties.

F. The District Court Can Proceed To Grant NTP Relief without regard to the Resolution of the Section 271(a) Issue.

NTP does not dispute that the infringing BlackBerry system is a highly effective means of electronic communication that is used by millions of Americans, including "hundreds of thousands of federal, state, and local government personnel." Pet. 6-7. RIM has prospered by willfully infringing Mr. Campana's invention. The thinly veiled implication of RIM's petition, however, that this Court's granting its petition would secure the future of RIM's pirated system, or any American subscriber's usage of her BlackBerry, is disingenuous at best.

As the Federal Circuit made clear, and NTP argued in its opposition to RIM's unsuccessful petition to Chief Justice Roberts to stay the mandate, "RIM's argument based on the location of its Relay outside the United States does not apply to the asserted claims of the '592 patent (claims 40, 150, 278,

287, 653, and 654) because those claims do not include the 'interface' or 'interface switch' limitation," served by RIM's Waterloo Relay. *NTP III*, Pet. 50a. Five of these claims are fully affirmed on all grounds of claim construction, infringement, and validity, and RIM does not appeal any of these grounds. This means that, even if this Court were to grant RIM's petition and to reverse the Federal Circuit, RIM's operation of its BlackBerry system, as it is presently configured, would continue to infringe NTP's '592 patent. The district court can proceed to grant NTP injunctive relief without regard to the resolution of the Section 271(a) issue.[18] Thus, a grant of RIM's petition would not secure the future use of the BlackBerry system within in the United States.

CONCLUSION

For all of the reasons above, NTP respectfully submits that the petition for writ of certiorari should be denied.

Respectfully submitted,

BERT W. REIN
Counsel of Record
JAMES H. WALLACE, JR.
JOHN B. WYSS
KATHRYN COMERFORD TODD
ANDREW G. MCBRIDE
KEVIN P. ANDERSON
WILEY REIN & FIELDING LLP
1776 K Street, N.W.
Washington, D.C. 20006
(202) 719-7000
Attorneys for Respondent

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[18] RIM's discussion of a possible injunction in this case is a red herring. Pet. 12 n.4 (discussing *eBay, Inc. v. MercExchange, L.L.C.*, No. 05-130). There is no injunction currently in place in this case, and RIM's narrow appeal has nothing to do with a hypothetical future injunction. Similarly, the United States' interest in the precise parameters of such an injunction, Pet. 7 and Pet. 157a-163a, has nothing to do with this appeal. Moreover, RIM did not appeal to the Federal Circuit any aspect regarding the propriety or scope of the district court's prior injunction.